No. 11,667.

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

TODD C. FAULKNER,

Appellant,

vs.

JOHN T. GIBBS,

Appellee.

PETITION FOR REHEARING.

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PETITION FOR REHEARING.

To the Honorable Judges of the United States Court of Appeals for the Ninth Circuit:

Now comes the Appellant herein and petitions this Honorable Court for a rehearing of this case on the ground that serious errors of fact and law appear in the opinion delivered October 8, 1948, which if corrected would necessarily lead to a different conclusion and a reversal of the judgment below.

By its strict adherence to the literal wording of F. R. C. P. 52(a) this Court has been led into the position of adopting as its own a decree of the lower court which as to the new Fawn game is totally illogical and inconsistent upon its face.

As this Court stated on page 2 of its opinion, in describing the Gibbs game: "Each unit is operated by a separate player who *competes* with players operating the other units of the multiple assembly."

The trial court stated this salient fact in somewhat more forceful language as follows [R. 287]:

> "The Gibbs game is played *strictly* on a *competitive* basis . . ."

and then went on to explain that this was because

> ". . . the moment one winner has won, the play of the other stops automatically . . . and no time limit exists, . . . only one player may win and there is always a winner."

The trial court also found [R. 287] that the new Fawn game was *not* competitive since, as it said:

> ". . . under the (new) Fawn game there can be *any number of winners.* . . ."

because in the new Fawn game

> ". . . the time clock automatically stops all games."

As a result of these findings the trial court decided that since the new Fawn game was *not* competitive, and since claim 6 called for a *competitive* game, that therefore claim 6 and its dependent claims 7 and 8 were not infringed by the new Fawn game.

But then, through obvious inadvertence, the trial court ruled that claims 9 and 10 *which were expressly limited*

to a competitive game in almost the same language as used in claim 6, *were* infringed.

This of course, *on the face of it,* cannot be correct. Surely this court did not mean to put its stamp of approval on an error which is so clearly apparent from even a cursory comparison of claims 6 and 9.

The lower court also violated the basic fundamentals of patent law when it held that the new Fawn game infringed claim 3 which specifically calls for:

> "supplementary means for indicating a winning play when all of the indicators in one of said groups has been energized."

when there is obviously no supplementary signalling means of any kind in the new Fawn game.

It is believed that this Court did not intend by its application of Rule 52(a) to adopt as its own the foregoing errors of the Trial Court.

It is therefore respectfully submitted that a rehearing should be granted in this case to permit the Court to reconsider its stand on the above questions and also to reconsider its ruling with respect to the validity of the patent in suit and the question of infringement of the original Fawn game, both of which rulings are believed to be contrary to the facts of this case and the law of this Circuit.

SUMMARY OF ARGUMENT.

A.

Since the Trial Court Found That Claims 6, 7 and 8 Were Limited to a Competitive Game and Therefore Not Infringed by the New Fawn Game, It Follows as a Matter of Course That Claims 9 and 10, which Likewise Describe a Competitive Game, Cannot Possibly Be Infringed by the New Fawn Game.

1. The Trial Court Held:

   (a) That Claims 6, 7 and 8 Were Limited to a Competitive Game;

   (b) That the New Fawn Game Was Not a Competitive Game; and

   (c) Therefore That the New Fawn Game Did Not Infringe Claims 6, 7 and 8.

2. Claim 9 Like Claim 6 Is Expressly Limited to a Competitive Game and by the Trial Court's Own Reasoning Is Not Infringed by the New Fawn Game.

3. Claim 10 Being Dependent Upon Claim 9 Is Not Infringed by the New Fawn Game for the Reasons Above Set Forth.

B.

The New Fawn Game Does Not Infringe Claim 3 of the Gibbs Patent Because It Omits One of the Essential Elements of Said Claim, To-Wit, the Supplementary Signal Means for Indicating a Winning Play.

1. Claim 3 by Its Terms Is Specifically Limited to a Game Unit Having Supplementary Signal Means for Indicating a Winning Play.

   (a) In the Gibbs Game This Supplementary Signal Means Is the Electric Globe L at the Top of Each Game Unit.

   (b) The Original Fawn Game Likewise Had an Electric Globe at the Top of Each Game Unit.

2. The Trial Court Found [R. 37] That There Were No "Electric Globes" (Win Signals) on the New Fawn Game Units.

3. Therefore the New Fawn Game Cannot Possibly Infringe Claim 3 Because It Omits an Essential Element Thereof.

C.

The Original Fawn Game Did Not Infringe Any of the Gibbs Claims in Suit.

1. All of the Gibbs Claims Must Be Limited to an Electrical Game in Which Relays Are Employed to Energize the Indicator Lamps in Response to the Closing of Separate Contact Switches.

2. The Old Fawn Game Did Not Employ Relays or Any Equivalent Thereof.

3. Therefore the Old Fawn Game Did Not Infringe Any of the Gibbs Claims Because an Essential Element Thereof Was Omitted.

D.

All of the Gibbs Claims in Suit Are Invalid Over the Prior Art of Record.

1. Claim 3 Merely Defines a Single Unit of the Gibbs Game Without Limitation as to Where That Unit Is Used or How, if at All, It Is Interconnected With Any Other Game Units.

   (a) **When Construed as by the Trial Court, Each and Every Element of Claim 3 Is Found in the Prior Nakashima Patent,**

   (b) **Therefore Claim 3 Is Anticipated by Nakashima.**

2. Claims 6 to 10, Inclusive, Are Invalid for Lack of Invention Over Nakashima in View of the Competitive Game Patents Issued to Chester, Prina, Higuchi, Etc.

3. There Was No Invention Involved in Interconnecting a Plurality of Old and Well Known Units in an Old and Well Known Manner.

   (a) **Consequently Claims 6 to 10 Are Invalid for Lack of Invention.**

E.

Claims 9 and 10 Are Additionally Invalid Because by Their Terms They Describe a Game Different From the One Illustrated in the Gibbs Patent.

ARGUMENT.

A.

Since the Trial Court Found That Claims 6, 7 and 8 Were Limited to a Competitive Game and Therefore Not Infringed by the New Fawn Game Because It Was Non-competitive, It Follows as a Matter of Course That Claims 9 and 10, Which Like Claims 6, 7 and 8 Describe a Competitive Game, Cannot Possibly Be Infringed by the New Fawn Game.

Since this Court did not render an independent opinion in this case but merely adopted the lower court's opinion, it is necessary in this petition to direct our remarks to the trial court's opinion and the errors therein which this Court has adopted.

The opinion of the Trial Court was given orally from the bench upon the close of the trial. Since the Findings of Fact, Conclusions of Law and Decree all omit any mention of the fact that claims 6, 7 and 8 were held not to be infringed by the new Fawn game, we must turn to the Trial Court's statements from the bench for this information.

1. THE TRIAL COURT HELD:

   (a) That Claims 6, 7 and 8 Were Limited to a Competi- Game;

   (b) That the New Fawn Game Was Not a Competitive Game;

   (c) And Therefore, That the New Fawn Game Did Not Infringe Claims 6, 7 and 8.

Let us now examine some of the various statements made by the Trial Court relative to the above holdings.

In answering one of Mr. Huebner's remarks the Court stated [R. 262 and 263] as follows:

> "The Court: I have in mind the principle you also have in mind, if a different result is obtained which is substantial, then there is no infringement, and if that result in the game is important, the question arises. That is why I think the question I have discussed should be more properly directed to you. *That is the fundamental distinction,* that while there is a possibility that several persons may win, and also the possibility that no one might win in his (the new Fawn) game, while your (Gibbs) game goes on until somebody wins. *So here are two differences in result.* His game stops automatically after a minute and a half. Your game goes on until somebody wins."

In response to further argument by counsel for Appellee, Judge Yankwich stated [R. 266] as follows:

> "The Court: I don't quite get the trend of your thought. It seems to me that the latter part of that claim (claim 6), the wording would not be read on the altered (Fawn) game, as you call it, the new game, *because there is no de-energization, de-energization does not occur,* because the game goes on. In other words, in the second (Fawn) game, if the person wins, the play goes on until the clock strikes, while in your (Gibbs) game automatically the other players are left out in the dark as it were and the game stops.
>
> "For that reason *I can't see how this latter part can be said to be anywhere read upon it.* If I understand correctly, the word 'de-energized' means that the electrical current which had operated on these units is off, or momentarily it does not have any effect."

At the close of its discussion of this problem the Court epitomized its views and stated its positive conclusion that there was an essential difference between the Gibbs game as defined in claim 6 and the new Fawn game, because the Gibbs game was competitive and the new Fawn game was not competitive. At R. 269 we find the Court stating as follows:

> "I will put it this way, in non-electrical terms: the de-energizing takes place at a different time, and is not done automatically by the instrument itself, but by means of a clock, and at a future, which is a lapse of time depending not upon one winning alone having been completed, but a lapse of time depending upon an arbitrary time limit set by the operator.
>
> "I have expressed it non-electrically, but it does seem to me that the addition and changing of results makes (claim) 6 clearly inapplicable. In other words, here is your danger: if you take a thing that achieved a different result, does it on a time basis, and does it by adding a new electrical apparatus which operates outside the machine, although it is connected with it, and you claim it is within the description, you are falling into the very pitfall which the Supreme Court adverted to in the Halliburton case, where you are claiming too broadly, and your claim becomes too broad by reason of indefiniteness."

That the foregoing quotations from Judge Yandwich's remarks during the course of his discussion with counsel for Appellee fairly state his conclusion that *the Gibbs game was a competitive game while the new Fawn game was not a competitive game,* is borne out by the latter

part of his oral opinion commencing on R. 287 where we find the following:

> "* * * , the (new) Fawn game is played for a definite time—a minute and a half, making it possible for two persons to win during the course of the game, one after the other. *The Gibbs game is played strictly on a competitive basis,* and the moment one winner has won, the play of the other stops automatically, and this automatic stop is achieved by the electrical mechanism itself, and no time limit exists.
>
> "The result is that under the (new) Fawn game there can be any number of winners, and it is possible that no one should win, during that time, while under the Gibbs game only one player may win, and there is always a winner, because the game does not stop until one person has won. In the other (new Fawn) game as I have already stated, the time clock automatically stops all games and the clock is connected with a mechanism as an instrument complete in itself, which is outside of the construction itself.
>
> "* * * *I do not think that claim 6 is infringed (by the new Fawn game)* and I think if you read them the way counsel desires me to read them, they would fall under the interdict of the recent decision of the Supreme Court in Halliburton v. Walker."

It is abundantly clear therefore from the foregoing quotations that the Trial Court not only found once but several times that:

(a) The Gibbs game as defined by claim 6 is a competitive game because when one player wins, *the other game units are automatically deenergized* thus making it impossible to have more than one winner;

(b) The New Fawn game is not a competitive game because *the other game units are not deenergized* when a win is made on one unit, but on the contrary they continue to operate for a time fixed by the clock so that there may be several winners;

(c) Therefore the new Fawn game does not infringe claim 6 (or its dependent claims 7 and 8).

2. CLAIM 9 LIKE CLAIM 6 IS EXPRESSLY LIMITED TO A COMPETITIVE GAME AND BY THE TRIAL COURT'S OWN REASONING IS NOT INFRINGED BY THE NEW FAWN GAME.

As stated by the Trial Court, the Gibbs game is competitive because a win on one of the game units disconnects the other units so that the indicator lamps thereof may not thereafter be illuminated by the competing players. In other words, the players play against each other. The means for accomplishing this result is set forth in claim 6 as follows:

> "means whereby when all of the indicators in any group of any of said units have been operated to complete a winning play, *the indicators on all of the units except the winning unit will be de-energized.*"

In claim 9 this element is described as:

> "means controlled by the closing of the signal circuit of the winning unit for discontinuing the signals and *opening the circuit of the indicators of all the other units.*"

By a simple comparison of the above language in claims 6 and 9, it is obvious that these claims describe exactly the same structure, to-wit: the element in the Gibbs game which makes it a competitive game.

In view of the very clear rulings of the Trial Court that *the new Fawn game does not have the competitive feature of claim 6, it is obvious that the new Fawn game cannot possibly infringe claim 9 which includes that same feature.* The old axiom of geometry that "things equal to the same thing are equal to each other" applies equally in the field of law.

Since the Trial Court ruled that the new game was non-competitive and therefore did not infringe claim 6, it was an obvious mistake on the part of the Court to rule that claim 9 which also calls for a competitive game was infringed by the new Fawn game.

This Court should not confirm a ruling *that is illogical and inconsistent on its face!*

3. CLAIM 10 BEING DEPENDENT UPON CLAIM 9 IS NOT INFRINGED BY THE NEW FAWN GAME FOR THE REASONS ABOVE SET FORTH.

Claim 10 reads as follows:

> "a game apparatus as characterized in claim 9, including an audible signal commonly connected with all of said units * * *"

It is axiomatic that a claim written in dependent form incorporates by reference all parts of the claim from which it depends. In other words, claim 10 as written, is merely an abbreviated form of claim 9 plus the additional element of the audible signal.

Consequently, since claim 9 is not infringed by the new Fawn game, claim 10 cannot be infringed either. As matter of fact, claim 10 is additionally not infringed because the new Fawn game does not have an audible sig-

nal. However, since we do not need any additional reasons for our position it will not be discussed.

We respectfully submit that the confirmation by this Court of a decree that is illogical and inconsistent on its face is adequate grounds for granting a rehearing. To do otherwise would be a gross miscarriage of justice.

B.

The New Fawn Game Does Not Infringe Claim 3 of the Gibbs Patent Because It Omits One of the Essential Elements of Said Claim, To-wit, the Supplementary Signal Means for Indicating a Winning Play.

It is elemental patent law that the omission of an element of a claim avoids infringement of that claim. As stated by this Court in the case of *Dunkley v. Central Calif. Canneries,* 7 F. 2d 972,

> "A defendant who omits one of the material elements of the combination does not infringe."

This basic doctrine was again stated by this Court in somewhat similar language in the case of *Magnavox Co. v. Hart & Reno,* 73 F. 2d 433, 23 U. S. P. Q. 211, as follows:

> "If the defendant omits one or more of the material elements which make up the combination, he no longer uses the combination; and it is no answer to say that the omitted elements are not essential, and that the combination operates as well without them as with them."

1. CLAIM 3 BY ITS TERMS IS SPECIFICALLY LIMITED TO A GAME UNIT HAVING SUPPLEMENTARY SIGNAL MEANS FOR INDICATING A WINNING PLAY.

In the Gibbs game a win by any player is indicated by instant illumination of a supplementary electric globe L on the top of the winner's game unit. The importance of this win signal is stressed throughout the Gibbs specification, as for example, on page 2, at line 78 [R. 304] where it is described as a "supplementary indicator lamp L," and again on page 4 at line 54 [R. 306], where it is referred to as "the master indicator L." In claim 3 it is described as follows:

> "supplementary means for indicating a winning play when all of the indicators in one of said groups have been energized."

That Gibbs considered the win signal a very important element of his invention is indicated by the large number of times that it is mentioned in the specification. Even the Trial Court adverted to this feature in quoting from the preamble of the Gibbs specification [R. 286] as follows:

> "* * * and the winning play made by any one of the players on a particular unit will operate to give an additional signal of such winning play, * * *"

The original Fawn game like the Gibbs game had an electric globe [numeral 22, R. 325] at the top of each unit to visually indicate a win on that unit. We agree with Appellee that this electric globe in the old Fawn game was the signal lamp L called for in Gibbs' claim 3. However, *there is no such signal in the new Fawn game!*

2. THE TRIAL COURT FOUND [R. 37] THAT THERE WERE NO "ELECTRIC GLOBES" (WIN SIGNALS) ON THE NEW FAWN GAME UNITS.

In view of the fact that the Findings as prepared by the Appellee were signed by the Trial Court without change, the Appellee cannot be heard to say that the omission in the new Fawn game of the "electric globes at the top of each unit of" the old Fawn game does not constitute *omission of the win signal L called for by claim 3* of the Gibbs patent. The situation is simply this:

(a) Gibbs claim 3 calls for a supplementary win signal;

(b) The old Fawn game had such a signal;

(c) The new Fawn game does not have such a signal;

(d) Therefore the new Fawn game cannot possibly infringe claim 3, because it omits an essenial element thereof.

It is fundamental patent law that the omission of an essential element from a claim avoids infringement of that claim. (See Law Points in the Supplement of our Opening Brief.)

Since there are no win light globes on the new Fawn game units as called for by claim 3, there can be no infringement of claim 3 by the new Fawn game. The Trial Court and this Court have clearly committed error in not so holding, and a rehearing should be granted to rectify that error.

C.

The Original Fawn Game Does Not Infringe Any of the Gibbs Claims in Suit.

This point was of course discussed at considerable length in Appellant's Opening Brief, and will only be treated briefly in this Petition. However, it is our position that the Trial Court erred as did this Court in finding infringement by the old Fawn game.

1. ALL OF THE GIBBS CLAIMS MUST BE LIMITED TO AN ELECTRICAL GAME IN WHICH RELAYS ARE EMPLOYED TO ENERGIZE THE INDICATOR LAMPS IN RESPONSE TO THE CLOSING OF SEPARATE CONTACT SWITCHES.

The Gibbs switches which are operated by the ball dropping through holes on the playing board do not energize the indicator lamps, but on the contrary, energize an intermediate electric relay which in turn energizes the indicator lamps and keeps them energized during the play. In other words, Gibbs, in order to operate his twenty-five lights employs twenty-five separate relays in addition to his twenty-five separate switches. This is clearly brought out in the Gibbs specification and claims.

The only way that the claims in suit can be held valid is to limit them to the said relays. Unless so limited, the claims read squarely on the prior art. If so limited, the claims are not infringed by the Old Fawn game, or by the new game either.

2. THE OLD FAWN GAME DID NOT EMPLOY RELAYS OR ANY EQUIVALENT THEREOF.

The old Fawn game instead of using the relay type electrical circuit employed by Gibbs (which was well known in the art prior to Gibbs' time) employed an overbalanced switch. By this simple expedient the Appellant avoided having to use the twenty-five relays of the Gibbs game.

As indicated by the prior art, there are many ways of accomplishing the end-result of the Gibbs patent, only one of which ways is shown and claimed by Gibbs. The Appellant used a different means for accomplishing illumination of his indicator lamps, said means being a variation of the Nakashima system.

There are no relays, or any equivalent thereof in either of the Fawn games.

3. THE OLD FAWN GAME DID NOT INFRINGE ANY OF THE GIBBS CLAIMS BECAUSE AN ESSENTIAL ELEMENT THEREOF HAS BEEN OMITTED.

This conclusion follows inescapably from the facts set forth above. It is felt that the Trial Court in finding infringement of the Gibbs patent by the old game was clearly in error. This Court has confirmed that error without substantial comment.

D.

All of the Gibbs Claims in Suit Are Invalid Over the Prior Art of Record.

In reaffirming the doctrine set forth in *Klein v. City of Seattle,* 77 Fed. 200, this Court in the more recent case of *Keszthelyi v. Doheny Stone Drill Co.,* 59 F. 2d 3, 13 U. S. P. Q. 427, stated as follows:

> "A patent must combine utility, novelty and invention. It may in fact embrace utility and novelty in a high degree, and still be only the result of mechanical skill as distinguished from invention . . . It is not enough that a thing shall be new . . . and that it shall be useful, but it must under the constitution and statute, amount to an invention or discovery."

1. CLAIM 3 MERELY DEFINES A SINGLE UNIT OF THE GIBBS GAME WITHOUT LIMITATION AS TO WHERE THAT UNIT IS USED OR HOW, IF AT ALL, IT IS INTERCONNECTED WITH ANY OTHER UNITS.

From the statements of the Trial Court it is apparent that the Court was confused and did not realize the above fact. When it is remembered that claim 3 has no relation whatsoever to the method of interconnecting a number of game units but reads on a single game unit isolated from the balance of the Gibbs' disclosure, it is readily seen that the broad construction given to claim 3 by the Trial Court makes the claim read directly on the prior art patent to Nakashima.

If claim 3 is limited to relays as the Patent Office Examiner very clearly thought it was, then the claim does not read on the Nakashima patent; but by the same token it does not read on either the old or new Fawn games.

The Appellee, the Court below and this Court have all chosen to give claim 3 a broad interpretation in order to find infringement of the old Fawn game. By this interpretation claim 3 is clearly invalid since each and every element thereof is met by Nakashima.

2. CLAIMS 6 TO 10, INC., ARE INVALID FOR LACK OF INVENTION OVER NAKASHIMA IN VIEW OF THE COMPETITIVE GAME PATENTS ISSUED TO CHESTER, PRINA, HIGUCHI, ETC.

Claims 6 to 10 define the complete Gibbs aggregation, to-wit, a plurality of his individual claim 3 units interconnected in a manner such that when a win is made on one unit, all of the other units are immediately disconnected. This concept was old in the art long prior to Gibbs as clearly shown in the above-mentioned patents and the other competitive game patents discussed in Appellant's Briefs.

Since prior to Gibbs the individual units were old as shown by the Nakashima patent and since the method of interconnecting a plurality of these units in the manner claimed by Gibbs was old as shown in the Chester, Prina, Higuchi and other competitive game patents, it certainly did not involve any invention to assemble a plurality of the Gibbs individual units into a bank as recited in claims 6 to 10, inclusive.

Consequently, it is apparent that claims 6 to 10 are invalid for lack of invention over the prior art and should have been so held by the Trial Court. It is submitted that the Trial Court committed error in holding the Gibbs patent valid and that this Court has by affirming the lower court decision, committed the same error.

E.

Claims 9 and 10 Are Additionally Invalid Because by Their Terms They Describe a Game Different From the One Illustrated in the Gibbs Patent.

This subject was gone into thoroughly in Appellant's Briefs. Even a cursory reading of the claims and a comparison of them with the disclosure of the Gibbs patent illustrates the correctness of the above statement. Very obviously claim 9 does not read on the patentee's own disclosure. As a result thereof claim 9 is invalid as contrary to the statutes. This is elemental patent law as set forth in Appellant's Law Points in his Opening Brief.

It is believed that this Court will wish to re-examine claims 9 and 10 to ascertain the correctness of the above statements.

Conclusion.

We respectfully submit that this Court by its adherence to Rule 52(a) has reached conclusions on all of the issues mentioned which are contrary to both the facts and the law of the case. It is consequently urged that a rehearing be granted herein and that Appellant be granted the opportunity of further briefing and arguing the points which we believe clearly show the Gibbs patent to be both invalid and not infringed.

While the matters of validity and infringement by the *old* Fawn game may be said to be controversial, there can be no real controversy with respect to the *new* Fawn game.

The lack of infringement by the new Fawn game is so clear under the trial court's own rulings that simple justice requires a rehearing in this case to permit this Court to correct the inconsistency in the decree below.

Respectfully submitted,

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Attorneys for Appellant.

Certificate.

It is hereby certified that in my judgment the foregoing Petition for Rehearing is well founded and is not interposed for delay.

ROBERT W. FULWIDER.